



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. :	09/867,223	Docket No. :	11032/3073
Inventor :	Jonathan BARSADE et al.	Confirmation No. :	5920
Filed :	May 29, 2001	Customer No. :	23838
Examiner :	Yehdega RETTA	Art Unit :	3622

For : NETWORK BANNER ADVERTISEMENT SYSTEM AND METHOD

Mail Stop **Appeal Brief – Patents**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

REPLY BRIEF UNDER 37 C.F.R. §41.41

Sir:

Appellants respectfully submit this Reply Brief in response to the Examiner's Answer mailed February 21, 2008 in the above-referenced application.

ARGUMENT

Claims 1-42: The Cited Art Does Not Teach or Suggest An Advertisement Served In Association With A Displayable Status Indicator Of Concurrent Download Activity Of A New Network Data Stream.

In the Appeal brief (filed Nov. 26, 2007), Appellants explained that the cited references (combination of Slotznick '537 and Slotznick '146) fail to teach or suggest an advertisement “served up...in association with a displayable status indicator of the concurrent downloading activity of the new network data stream” as claimed. In the Examiner's Answer, the Examiner again admits that Slotznick '537 fails to teach downloading a displayable status indicator of

concurrent downloading activity of a new network data stream, and again relies on Slotznick '146 for this feature, repeating the discussion made in the final rejection. However, like the final rejection, the Examiner's Answer fails to recognize that one cannot combine references to achieve a claimed invention if one reference teaches away from the desired result. In this case, Slotznick '146 teaches away from the desired result of displaying an advertisement while a new network data stream is being downloaded.

In addressing the Examiner's position that the cited references disclosed an advertisement served up in association with a displayable status indicator of the concurrent downloading activity, Appellants pointed out that Slotznick '146 merely indicates that some programs provide an estimate of processing times, and that there is no suggestion that this estimated processing time is ever displayed in association with an advertisement. Appeal Brief at 5. In response to Appellants' argument, the Examiner posits that Appellants only considered the two cited references individually and failed to consider the combined teachings of the references. Examiner's Answer at 8.

However, Appellants did consider the combined teachings of the references. Specifically, Appellants argued that Slotznick '146 **teaches away from displaying an advertisement during downloading activity**, because the system described in Slotznick '146 is used to block interstitial advertisements. Appeal Brief at 5. Interstitial advertisements are advertisements displayed while the user is waiting for a new web page to download.¹ Because Slotznick '146 teaches that it is desirable to block interstitial advertisements, and thus teaches away from actively storing, selecting, and displaying advertisements while a new network data stream is being downloaded, Appellants concluded that it would not have been obvious to one of skill in the art to use the advertisement-blocking technology of Slotznick '146 to display advertisements in the system of Slotznick '537 while waiting for a web page to download. Appeal Brief at 5-6. The Examiner's Answer simply ignores this teaching of Slotznick '146, and in so doing disregards the axiom that a combination of references cannot achieve the claimed invention if one reference teaches away from the desired result.

¹ As discussed in Slotznick '146, "interstitial" time refers to "the time period from when a user clicks on a hyperlink in an Internet web page (in order to access a new Internet web page) until that new web page has finished downloading to the user's computer and has been displayed." Slotznick '146, col: 2 at lines 58-61.

Accordingly, claims 1-42 are allowable over the cited art, and the rejection of these claims should be reversed.

Claims 31-42: The Cited Art Does Not Disclose An Activation Code.

In the Appeal brief, Appellants pointed out that the Examiner failed to explain where the cited references disclose the use of a BA activation code as claimed. In response, the Examiner argues that Slotznick '537 teaches a virtual page as first displayed (“primary” information) upon download that includes embedded information that is downloaded and stored. More specifically, the Examiner now argues (relying on example from col. 25 lines 1-18) that the “primary” information in Slotznick '537 includes code (presumably the claimed BA activation code) embedded in the page that provides a request for specific “secondary” information – namely, a banner advertisement. Examiner’s Answer at 9-10.

However, Slotznick '537 does not teach that any such code embedded in primary information is a BA activation code as described and claimed in the present invention. The specification explains that the BA activation code includes programming language that “submit requests to the BA server to submit BA files” and “enable the BA features ... including instructions ... to launch the BA file upon submitting the request for the requested second web page.” Specification, page 14 lines 23-28. Similarly, claim 31 recites “**submitting a request from the user computer** to the second network server for a first **network data stream that includes a BA activation code**” and “**submitting a request** to the first network server for a **first BA data stream, wherein the request is initiated by the BA activation code.**” Thus, in the present invention, two requests are made to obtain a web page with an advertisement: first, a request is made by the user for a data stream, the data stream including a BA activation code; and second, the BA activation code initiates a request for the advertisement.

Contrary to the claimed invention, the example in Slotznick '537 (col. 25 lines 9-18) relied upon by the Examiner merely describes how a web page is transmitted first with text and blank boxes, and then primary and secondary images are transmitted to replace the blank boxes. This does not mean, however, that the web page described in this example from Slotznick '537 includes an activation code (with features enabling control over when and how a banner ad is displayed) that is downloaded to the user’s computer and then makes a request to a network

server for a banner advertisement, as claimed in the present invention. Nothing in the example shows the use of two requests to obtain a web page with an advertisement. Similarly, nothing in the remaining material cited by the Examiner shows use of an activation code as claimed.

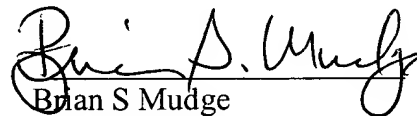
Accordingly, claims 31-42 are allowable over the cited art, and the rejection of these claims should be reversed.

CONCLUSION

For at least the reasons discussed herein, as well as the reasons discussed in the Appeal Brief, claims 1-42 are allowable over the cited art. Appellants respectfully request reversal of the rejections of claims 1-42.

Although it is believed that no fees are due for this Reply, any fees associated with this appeal are authorized to be charged to the deposit account of Kenyon & Kenyon LLP, Deposit Account No. 11-0600.

Respectfully submitted,


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